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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/637,802	05/08/96	ECCLES	C-35469

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IM41/0302

EXAMINER
SHEEHAN, J

ART UNIT	PAPER NUMBER
1742	22

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/637,802

Applicant(s)
Eccles

Examiner
John P. Sheehan

Group Art Unit
1742



☒ Responsive to communication(s) filed on Dec 16, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-4, 6-15, and 17-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4, 6-15, and 17-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on December 16, 1998 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/637,802 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 to 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

I. It is not clear what applicants are attempting to claim in claim 1, lines 5 and 6. On the one hand the minimum silicon content is 0.2 % while on the other hand the minimum total of silicon and zinc is 0.07%. It is not clear how silicon can have a minimum content of 0.2% and the total of zinc and silicon have a minimum of only 0.07%?

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 to 4, 6 to 15 and 17 to 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernard et al. '479 taken in view of Rateau et al. (Great Britain patent document 2,255,348).

Bernard et al. '479 teaches reduced fire scale silver-copper alloys (column 2, lines 24 to 34) consisting essentially of, in weight percent,

silver	89.3 to 93.5%
copper	0.5 to 6%
zinc	0.5 to 5%
silicon	0.1 to 2%
boron	0.001 to 2%
tin	0.25 to 2%
indium	0.01 to 1.25.

This alloy is made by alloying silver with a master alloy (column 2, lines 34 to 37) consisting essentially of, in weight percent,

silicon	0.9 to 30.7%
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boron	0.001 to 30.7%
zinc	4.5 to 76.9%
copper	4.5 to 92.3%
tin	2.2 to 30.7%
indium	0.09 to 19.2%.

Rateau et al. teach that adding 0.5 to 3 % weight germanium to a silver-copper alloy (page 3, lines 2 to 4) improves the hardness of the silver-copper alloy (see, for example, page 5, lines 11 to 13, page 6, Table II, Alloys 3 and 4).

The claims and Bernard et al. '479 differ in that Bernard et al. '479 do not teach the exact proportions for each of the alloy components nor does Bernard et al. '479 teach the use of Ge.

However, one of ordinary skill in the art at the time the invention was made would have been motivated to add Ge to Bernard et al. '479's alloy so as to improve the hardness of the resulting alloy as taught by Rateau et al.

Response to Arguments

6. In view of the Examiner's comments in the Advisory Action mailed, September 25, 1998, applicant, in anticipation of the Examiner making the above prior art rejection, presented arguments filed December 16, 1998. These arguments have been fully considered but they are not persuasive.

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Applicant's arguments that Rateau et al. (referred to by applicant as GB 2,255,348) does not teach the inclusion of zinc and silicon in sterling or near sterling silver alloys nor the inclusion of silicon or zinc with Ge in sterling or near sterling silver alloys and that Rateau et al. teach that silicon causes silver alloys to be brittle while the instantly claimed alloy is not brittle are not persuasive. Applicant while stating that the instant alloy is not brittle has not presented any evidence to support such a statement. Further, the Examiner is not relying on Rateau et al. to teach the addition of zinc and/or silicon to sterling or near sterling silver alloys nor is the Examiner relying on Rateau et al. to teach the inclusion of silicon or zinc with Ge in sterling or near sterling silver alloys. Instead, the Examiner is relying on Rateau et al. for its teaching that the addition of Ge to Ag-Cu alloys improves the final hardness of the Ag-Cu alloy. As set forth above in the statement of this prior art rejection Rateau et al. clearly teaches this principle.

Applicant's argument that Bernard et al. '479 does not teach the addition of Ge to an Ag-Cu alloy is not persuasive. The Examiner is not relying on Bernard et al. '479 to teach the addition of Ge to Ag-Cu alloys but rather is relying on Bernard et al. '479 to teach essentially applicant's alloy absent the Ge. As set forth above in the statement of this prior art rejection Bernard et al. '479 clearly teaches such a composition.

In response to applicant's arguments against Bernard et al. '479 and Rateau et al. individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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7. The declaration by Mr. Anthony Phillip Eccles under 37 CFR 1.132 filed September 16, 1998 is insufficient to overcome the rejection of claims 1 to 4, 6 to 15 and 17 to 23 based upon Bernard et al. '479 taken in view of Rateau et al. as set forth above in the instant Office action because:

I. There is no nexus between "the Apecs silver alloy" referred to in the declaration and the alloy composition recited in the instant claims, that is, there is no indication that "the Apecs silver alloy" is actually the alloy recited in the instant claims, MPEP 716.03(a).

II. With respect to the long felt need section of the declaration, there is no objective evidence to support Mr. Eccles' allegation that a long felt need existed, MPEP 716.04. The statement that United Precious Metals "had an interest and desire" to develop the instant invention is an opinion which is unsubstantiated with any factual evidence, MPEP 716.01(c).

III. The declaration state(s) that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no showing that persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references and still were unable to solve the problem. See MPEP §716.04.

IV. With respect to the commercial success section of the declaration there is no objective evidence to support Mr. Eccles' allegations that the instantly claimed alloy was a commercial success, MPEP 716.04.

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V. Further, it is noted that the applicant, Mr. Anthony Phillip Eccles, who signed this declaration is not employed by United Precious Metals and there is nothing in the record that gives Mr. Eccles the authority to speak for United Precious Metals regarding United Precious Metals' opinions regarding the long felt need and the commercial success of the instantly claimed alloy.

8. The declaration by Melvin Bernard under 37 CFR 1.132 filed December 16., 1998 is insufficient to overcome the rejection of claims 1 to 4, 6 to 15 and 17 to 23 based upon Bernard et al. '479 taken in view of Rateau et al. as set forth above in the instant Office action because:

I. The declaration state(s) that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no showing that persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references and still were unable to solve the problem. See MPEP §716.04.

II. In the first line on page 2 of the declaration, United Precious Metal is described as "the licensee" of the instant patent application. The Examiner questions whether United Precious Metal is the only licensee of the instant application or whether United Precious Metal is the exclusive licensee of the instant application. In order to fully evaluate Mr. Bernard's declaration it is essential that the Examiner be made completely aware of whether United Precious Metal is the only licensee of the instant application or whether United Precious Metal is the exclusive licensee

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of the instant application so that it is apparent what Mr. Bernard's direct or indirect interest is in the instant application.

III. There is not a consistent nexus between the instantly claimed alloy composition and the silver alloy(s) discussed in the declaration. On page 4 of the declaration the instantly claimed alloy composition is listed. It is stated that, "This new silver alloy is referred to further in this declaration as the 'Apecs Silver Alloy'." However, this exact phrase, Apecs Silver Alloy, does not appear in the declaration again. Instead, variants of the phrase are used, for example, "[t]his new Apecs silver alloy" (page 4, last paragraph, last sentence), "present invention" (page 5, line 3), "claimed invention" (page 5, last paragraph, first line), "claimed invention" (page 6, line 1 and paragraph 2, line 1) and "Apecs silver alloy" (page 6, lines 9, 13, 15 and 20). In view of the use of these various terms and not the consistent use of the term "Apecs Silver Alloy" it is not clear that Mr. Bernard is actually referring to the "Apecs Silver Alloy" as defined on page 4 of the declaration which definition is the same alloy as the instantly claimed alloy, MPEP 716.03(a).

III. Much of the declaration is Mr. Bernard's opinions, for example:

- "The silver alloys of the claimed invention have enjoyed a wide degree of acceptability for their silver color,...and other fine silver application" (page 2, paragraph 1, the last sentence)
- "In my opinion" (page 5, last paragraph; page 6, paragraphs 1, 3 and 4)
- The statements made on page 6, paragraph 2.

However, there is no probative evidence to support Mr. Bernard's opinions, MPEP 716.01(c).

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Conclusion

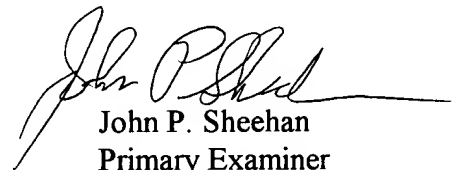
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner John P. Sheehan, whose telephone number is (703)-308-3861. The examiner can normally be reached on Tuesday-Friday from 6:30 A.M.-5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Mr. Prince Willis, can be reached on (703)-308-3050. The fax phone number for this Technology Center is (703)-305-3599.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

When filing a FAX in Technology Center, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

jps
February 27, 1999


John P. Sheehan
Primary Examiner
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